

REMARKS FOR PRELIMINARY AMENDMENT

Claims 17 and 18 have been amended to correct minor typographical errors in the claims. No new matter has been added.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability with the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

REMARKS TRAVERSING RESPONSE TO RESTRICTION REQUIREMENT

Reconsideration and withdrawal of the restriction and species election are respectfully requested in view of the remarks herewith.

As a traverse, it is noted that the MPEP lists two criteria for a proper restriction requirement. First, the inventions must be independent or distinct. MPEP § 803. Second, searching the additional inventions must constitute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application “[i]f the search and examination of an entire application can be made without serious burden, ... even though it includes claims to distinct or independent inventions.” *Id.*

With regard to the independent and distinct requirement for the restriction, this holding by the Examiner is traversed on a couple of grounds:

(1) Traversal of “Independent and Distinct” Characterization Between Groups I-II and Group III

The claims of Group II and Group III were restricted because “Group III is drawn to complex composition and is different from Groups I-II or IV, since it has additional ingredients (i.e. surfactants in claim 10 or acaracides, fungicides...growth-regulating substances in claim 11) that are not present in Groups I-II and IV. Thus, separate searches in the literature as well as in the U.S. Patent Classification System would be required.” (page 3, lines 13-17 of the Restriction Requirement) However, this assessment is incorrect.

First, the patentably distinct element of the invention are the compounds of claim 1 which is also by definition present in claims 10 and 11 as such both the claims of Group II and III require a search of the prior art for the compounds of claim 1.

Second, the relation between the compounds of claim 1 and the compositions of claims 10 and 11 is that of a subcombination-combination where the subcombination is essential to the combination. see MPEP 806.05(c), Section II. (“*If there is no evidence* that combination AB_{sp} is patentable without the details of B_{sp}, **restriction should not be required.**”)(emphasis added). As there has been no evidence submitted which suggests that the claims of Group III would be patentable without the element taught in the claims of Group II, this portion of the restriction can properly be rescinded.

(2) *Undue Burden Requirement Has Not Been Met for Non-consideration of Group I Claims*

With regard to the restriction between the claims of Group I and Group II, there has been no evidence presented to support the Examiner’s claim that searching both invention represents an undue burden on the office. While the different Groups of claims have been assigned separate Class/subclasses, this is merely a possible indicia of an unduly burdensome search and but is by no means dispositive. It is certainly not unusual for a granted U.S. Patent to have more than one Class/subclass listed in the Examiner’s “Field of Search” section cited on the face of the patent. In the present case, searching the chemical databases for the compounds represented by claim 1 would only appear to require expanding the search query used for the elected invention to encompass X = CH or N instead of merely X = -CH. Absent an evidence to the contrary, it is unclear how this act constitutes an undue burden on the office.

CONCLUSION

In view of the above, reconsideration and withdrawal of the restriction requirement is respectfully requested.

It is also believed that the application is in condition for allowance, and favorable consideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited.

Favorable action is earnestly solicited.

Respectfully submitted,

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